

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**THE CHAMBER OF COMMERCE OF THE  
UNITED STATES OF AMERICA**

Opposer,

v.

**UNITED STATES HISPANIC CHAMBER  
OF COMMERCE FOUNDATION**

Applicant.

)  
)  
) Opposition No. 91156321  
) (“parent” case)  
)

) Opposition No. 91156340  
) (“child” case)  
)  
)



12-04-2003

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #78

**OPPOSER’S MOTION  
TO REQUIRE SURRENDER OF REGISTRATION NO. 2,777,830,  
TO CONSOLIDATE THE PENDING PROCEEDINGS ,  
AND  
TO RESET DISCOVERY AND TESTIMONY PERIODS IN THE  
CONSOLIDATED PROCEEDING**

U.S. Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202

Sir:

COMES NOW Opposer, The Chamber of Commerce of The United States of America, and hereby moves the Board for an order requiring surrender of the Registration No. 2,777,830, to consolidate the pending proceedings Nos. 91156321 and 91156340 between Opposer and Applicant, and to reset the discovery and testimony periods of the consolidated proceeding.

As grounds for this motion, the Board is advised that Registration No. 2,777,830 has erroneously issued despite the pendency of a timely filed opposition, and that an opposition has been erroneously dismissed. The two pending proceedings are closely related. Each is an opposition with a counterclaim for cancellation. The parties are identical, the two opposed marks are closely related marks, and the counterclaims in both proceedings seek the cancellation of the same four registrations. However, the posture of the two proceedings differs significantly as discussed in more detail below.

Since many of the issues are common to both proceedings, significant judicial economy will be realized by consolidation, and resetting of the periods will obviate the present confusion generated by the differing posture of the proceedings and permit the orderly and simultaneous resolution of all issues.

Opposer opposed the first one of applicant's marks (the "First Mark") on April 11, 2003. The Notice Of Opposition contained a typographical error in the application serial number, and after consulting with the Board, Opposer filed a corrected Notice on May 7, 2003. Opposer understood that the corrected Notice was to be placed in the same file with the erroneous Notice and that only one proceeding would be instituted.

However, two opposition proceedings were erroneously initiated. The erroneous Notice as the First Mark was assigned No. 91156321 (the "'321 Opposition") and the discovery and testimony dates were originally set on May 15, 2003. Applicant answered and counterclaimed on June 24, 2003. However, the Board has not advised Opposer that the counterclaim was filed and thus the issue has not yet been joined on the counterclaims. As a result, the discovery and testimony dates originally set have not yet

been reset to acknowledge the existence of the counterclaim. Because the dates have not been reset, Opposer moved to extend the original dates on December 1, 2003.

The corrected Notice as to the First Mark was assigned No. 91156340 (the “ ‘340 Opposition”) and the discovery and testimony dates were originally set on May 16, 2003. Applicant answered and counterclaimed on June 24, 2003 and the Board reset the discovery and testimony dates in acknowledgement of the existence of the counterclaim on November 17, 2003.

Opposer opposed the second of applicant’s marks (the “Second Mark”) on May 14, 2003. That proceeding was assigned No. 91156775 (the “ ‘775 Opposition”) and the discovery and testimony dates were originally set on June 23, 2003. No answer or counterclaim was filed in the ‘775 Opposition. Thus, Applicant would be in default but for the erroneous dismissal of the proceeding by the Board.

On August 26, the Board dismissed the ‘775 Opposition, erroneously referencing as duplicates (1) the ‘321 Opposition as to the **First Mark** and (2) the ‘775 Opposition as to the **Second Mark**. This dismissal left pending (a) the ‘321 Opposition as to the **First Mark** and (b) the ‘340 Opposition as to the **First Mark**, and left no opposition pending as to the **Second Mark**.

The confusion has been compounded because the ‘321 Opposition as to the **First Mark** continues to bear the erroneous typographical error and is being treated as if it were an opposition as to the **Second Mark**.

Further error occurred when the Board cancelled the ‘775 Opposition as a duplicate and, despite the existence of a validly filed Notice and a pending opposition,

and remanded the application for registration of the **Second Mark** to the examining attorney who permitted the **Second Mark** to register as Registration No. 2,777,830.

Thus, there is now an erroneously issued registration and two opposition proceedings ostensibly directed to two different marks but in reality directed to the same mark.

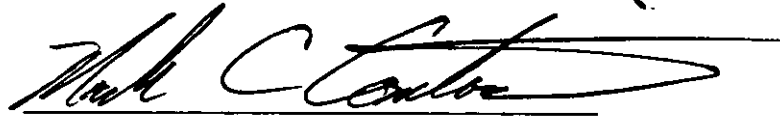
Further complicating the above is the fact that the '321 Opposition has been assigned by the Board to the **Second Mark**, and the applicant has acquiesced and answered as to the **Second Mark**, leaving officially pending one opposition as to the **First Mark** (the '340 Opposition) and one opposition pending as to the **Second Mark** (the '321 Opposition).

Requiring applicant to surrender the erroneously issued registration of the **Second Mark** will place the parties in the correct position. Consolidation of the two proceedings and resetting the discovery and testimony dates will correct all of the Board's errors and give the parties the opportunity to efficiently and fairly litigate all of the issues in the same proceeding.

The undersigned acknowledges the complexity of this situation but believes that the granting of this motion provides a simple solution in that it puts the parties in exactly the position they would have been in had the errors not occurred, i.e., a single proceeding in which registration of both marks is opposed and in which applicant's identical counterclaims are considered.

Counsel for Opposer is available to consult with the assigned paralegal ex parte or jointly with counsel for Applicant, in person or by telephone and invites contact to discuss the matter.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark C. Comtois', written over a horizontal line.

L. Lawton Rogers, III  
Mark C. Comtois  
Attorneys for Opposer

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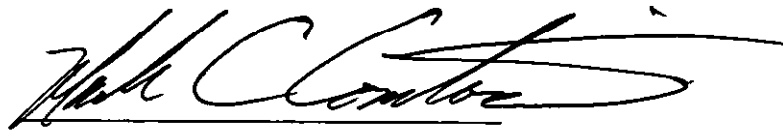
Dated: December 4, 2003  
WSH\105412.1

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing

**OPPOSER'S MOTION  
TO REQUIRE SURRENDER OF REGISTRATION NO. 2,777,830,  
TO CONSOLIDATE THE PENDING PROCEEDINGS ,  
AND  
TO RESET DISCOVERY AND TESTIMONY PERIODS IN THE  
CONSOLIDATED PROCEEDING**

was served on Attorney for Applicant, Evan R. Sotiriou, at his address of record,  
Armstrong Teasdale LLP, One Metropolitan Square, Suite 2600, St. Louis, Missouri  
63102-2740, by depositing same with the United States Postal Service, first-class mail,  
postage prepaid, this 4<sup>th</sup> day of December, 2003.

A handwritten signature in black ink, appearing to read "Mark C. Conlon", with a long horizontal flourish extending to the right.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**Applicant.**

Opposition No. 91156340  
("child" case)

# TRANSMITTAL

Trademark Trial and Appeal Board  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513


Sir:

Transmitted herewith is an Opposer's Motion to Require Surrender of Registration No. 2,777,830, to Consolidate the Pending Proceedings and To Reset Discovery and Testimony Periods in the Consolidated Proceeding for the above-identified proceedings.

If a Petition for an Extension of Time is necessary for the paper transmitted herewith to be timely filed, this transmittal is to be considered as a petition to extend the response period by the amount of time needed for the papers to be timely filed.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 04-1679. A duplicate of this sheet is enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark C. Comtois', written over a horizontal line.

L. Lawton Rogers, III  
Mark C. Comtois  
Attorneys for Opposer

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Date: December 4, 2003